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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,061	08/01/2001	Erwin Karl Meimer	TTLRCL.001A	6174

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EXAMINER	
CHRISTMAN, KATHLEEN M	
ART UNIT	PAPER NUMBER
3713	10

DATE MAILED: 08/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

EC

Office Action Summary	Application No.	Applicant(s)	
	09/921,061	MEIMER, ERWIN KARL	
	Examiner	Art Unit	
	Kathleen M Christman	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 June 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11 and 14-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11 and 14-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

In response to the amendment filed 06/26/2003, claims 12 and 13 have been cancelled; claims 1-11 and 14-20 are pending.

Response to Amendment

1. The evidence submitted is insufficient to antedate the applied reference to Vaughan.

In order to antedate a non-statutory bar prior art reference, an applicant must establish:

(A) A prior reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Vaughan reference; or

(B) Conception prior to the effective date of the non-statutory bar reference plus diligence from a time immediately prior to the effective date of the reference to a subsequent actual or constructive reduction to practice.

In general, proof of actual reduction practice requires a showing that the apparatus actually existed and worked for its intended purpose. Such evidence has not been submitted. The mere listing of the program files stored on the CD-ROMs (examiner notes that the actual CD-ROM has not been provided) does not demonstrate how they function to perform the claimed system and method. Further, applicant has submitted no evidence supporting the assertion that the CD-ROMs contained such systems and methods. As such the affidavit is not persuasive. In addition, these same items are lacking with respect to any alleged conception prior to the effective date of the Vaughan reference, so prior conception coupled with diligence to a later reduction to practice has not been established either.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 14 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 14 and 15 are indefinite because they are dependent upon a cancelled base claim. The examiner has assumed, for purposes of this action, that the claims should be dependent on claim 5.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 3-11, 14-17, 20-30, and 32-36, as broadly interpreted, are rejected under 35 U.S.C. 102(e) as being anticipated by Vaughan, Jr. (US 6419496 B1) for the reason's set forth in the office action date 04/10/2003 (paper no. 8) and incorporated herein by reference.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1, 2, 18, 19 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vaughan, Jr. (US 6419496 B1) in view of Ho et al (US 6212358 B1) for the reason's set forth in the office action date 04/10/2003 (paper no. 8) and incorporated herein by reference.

Response to Arguments

8. Applicant's arguments filed 06/26/2003 have been fully considered but they are not persuasive. Applicant stated that they disagree with the rejection of the claims, however applicant has not pointed out the patentable novelty, which he or she thinks the claims present in view of the state of the art disclosed by the references cited, or the objections made. Further, they do not show how the amendments avoid such references or objections. Instead applicant has maintained that the claims are patentably only if the Vaughan reference is removed as prior art. As the affidavit filed under 37 CFR 1.131 has been deemed insufficient the rejections based upon the Vaughan reference are deemed proper and thereby maintained.

The examiner acknowledges that the ship-date shown in Exhibit A of October 28th, 1999 occurs ten months prior to the earliest effective filing granted applicant and of the examiner's responsibilities according to MPEP § 715.10. However, absent any showing that the item shipped embodied the claimed invention, the evidence is not persuasive that applicant is entitled to a date of invention prior to the invention date of the Vaughan reference. Lastly, the examiner has cited below evidence regarding a course listing from San Diego State University dated March 10, 1999. This evidence indicates that a course utilized material entitled "Marketing Masterfully (CD)" by Total Recall as optional material. Applicant is requested to explain what if any relevance this material may have with regard to the claimed invention. Applicant is further requested to furnish the specifics of this material.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen M Christman whose telephone number is (703) 308-6374. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Theresa Walberg can be reached on (703) 308-1327. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

Joe H. Cheng
Primary Examiner

Kathleen Christman

August 13, 2003